

**REMARKS**

Claims 1-20 are pending in this application. Claims 1, 2, 4-8, 11, 13, 15 and 17 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. Claims 18 through 20 have been newly added.

**I. Response to Arguments**

The Examiner stated that "Applicant's arguments, see pages 2-21, filed 6/3/04, with respect to the rejections of claims 1-21 [17] have been fully considered and are persuasive and therefore, the rejection has been withdrawn."

The Applicant appreciates the Examiner's withdrawal of the rejection of all pending claims 1-17.

However, the Examiner stated that upon further consideration, a new ground(s) of rejection is made in view of Suzuki Japanese publication No. 03-274943, Konno et al. U.S. Patent No. 6,154,286, Ogura U.S. Patent No. 4,876,609 and Bloomfield U.S. Patent No. 6,693,729.

Respectfully, the Applicant believes that the present response will show that the new grounds of rejection should also be withdrawn as shown herein.

**II. Claim Objections**

The Examiner stated that Claim 13 is objected to because of the following informalities:

Perhaps "a transmitting part" should be "the transmitting part" in line 5. Claim 13 was corrected according to the Examiner's suggestion.

### **III. Claim Rejections - 35 USC § 103**

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**A. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Konno et al. The Applicant respectfully traverses.**

1. a. The Examiner stated with respect to claim 1, that Suzuki teaches receiving said data output order by said transmitting part from said receiving part after the telephone number of said receiving part is dialed (receiving reply from a receiver side facsimile).

However, Suzuki does not receive the data output order by the transmission side facsimile terminal 7 from the receiving side facsimile terminal 8. Instead, it is the separate storage exchange 1 (shown in figure 1) that makes all such processing. The storage exchange 1 is connected to the communication network 6 and the transmission side fax 7 and the receiving side fax 8 is also connected to the communication network 6 as seen in figure 1 of Suzuki. It is the output order processing section 32 of the original output processing section 3 which is of the storage exchange 1 connected to the communication network 6 that receives the output order information from the receiver and not the facsimile transmitting part as claimed in the present invention.

b. The Examiner also mentions that Suzuki teaches transmitting said stored document data according to said received data output order.

However, the facsimile of the transmitting part 7 of Suzuki is not transmitting the stored document data according to the received data output order, but the output processing center 3 of the separate storage exchange 1 connected to the network. On the other hand, as clarified in the amended claim of the present invention, there is transmitting by the facsimile of the transmitting part, the stored document data according to the received data output order.

Therefore, in Suzuki, a whole extra device is needed, and an extra path of transmission is necessary for the data to be printed according to instruction, whereas in the present invention, such

an extra apparatus is not necessary. In fact, there is also a lack of control at the transmitting end according to Suzuki as all such controls are in the separate storage exchange 1, whereas in the present invention, the transmission side fax receives the output order as claimed.

c. The Examiner states that Suzuki, however, does not teach expressly the method of *requiring* said data output order by said transmitting part. The Examiner also states that Konno, on the other hand, teaches a method for controlling transmission of fax data, the method comprising the steps of requiring and receiving capabilities of the receiving part by the transmitting part (phase B in fig. 8); and transmitting said stored document data according to the capabilities that the receiving part can receive (col. 11, lines 57-63).

However, looking phase B of figure 8 and col. 11, lines 57-63, the image data to be transmitted is subjected to image processing of resolution conversion and the size conversion received corresponding to the receiving performance of the receiving terminal by the CODEC 72. However, nowhere in Konno is the transmitting part requiring the capabilities of the receiving part, instead there is an image processing made. Moreover, specifically, Konno lacks the teaching of requiring the data output order by the transmitting part. Konno only mentions image processing such as resolution and size conversion. There still must be a teaching of the requiring the *data output order* by the transmitting part since Suzuki also lacks such a teaching.

The Federal Circuit has mentioned that “[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious.” *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50

(CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964). Here, no such teaching is ever made. Konno states that image processing features such as resolution and size conversion and this does not accommodate the modification of all the data output order. The actual teaching does not exist and an improper conclusion is made.

Moreover, stating that Konno teaches that since some capabilities are received from the receiving part and therefore, Konno can be modified to receive and require the data output order according to Suzuki is a conclusion rather than a reason for rejection and therefore, the rejection is quite improper.

In addition, even if combined with Suzuki, Kono would still not teach the transmitting part facsimile requiring the output order, because in Suzuki as shown above, it is the output control section 3 of the storage exchange 1 that separately accommodates the output order according to the receiving side fax 8 and not the transmission side fax 7 making such a requirement. The actual teaching must exist and not just a conclusion based on the present application such that the present application is improperly used as a blueprint for the rejection.

2. With respect to claim 2, the Examiner stated that the combination of Suzuki and Konno teaches the method of claim 1 and Konno further teaches the method comprising the step of displaying operation procedures in a display (col. 10, lines 57-59). Thus, it would have been obvious to ordinary skill in the art at the time of the invention to implement the display panel of Konno into the facsimile of Suzuki. The motivation/suggestion for doing so would have been to inform the user with transmitting procedures when the transmitting output order (operation procedures) has been .

changed according to the reply received from the receiver side (last six lines of Suzuki).

However, respectfully, displaying operation procedures is not the same as displaying the data output order. The Examiner is making a conclusion based on his own knowledge.

According to MPEP §2144.03 relating to “Reliance on Common Knowledge in the Art or ‘Well Known’ Prior Art” such reliance is not judiciously applied. Only in certain circumstances this can be done. The Examiner’s use of his knowledge does not meet the standards set in MPEP §2144.03 and therefore should not be used.

Furthermore, it is the right of the Applicant to demand authority be shown for all the reliance of what the Examiner calls as common knowledge. Basically, it would be helpful to the Applicant and greatly appreciated that the Examiner based his rejection on the references and not on his personal knowledge.

Moreover, according to MPEP §706.02(j), the prior art reference (or references when combined) must teach or suggest all the claim limitations and here even when combined only show a display, but not display of the data output order received from the receiving part.

3. With respect to claim 4, the Examiner stated that the combination of Suzuki and Konno teaches the method of claim 1 and Konno further teaches the method with both of said transmitting part and said receiving part supporting a non-standard mode, said receiving part reporting said data output order to said transmitting part by sending a predetermined bit of data (fig. 8).

However, as shown above, Suzuki does not report to the transmission part of the data output order, but to the separately connected storage exchange on the network. Konno also makes no

mention of the teaching of reporting said *data output order* to said transmitting part by sending a predetermined bit of data as Konno generally describes only image processing.

4. With respect to claim 5, the Examiner stated that Suzuki teaches said scanned document data being managed in a unit of a page and being stored in a memory of said transmitting part (last three lines). However, the last three lines show that output order information is stored on the store processing section 4 of the storage exchange 1 and not the transmission side facsimile 7.

5. With respect to claim 6, the Examiner stated that the combination of Suzuki and Konno teaches the method of claim 1 and Konno further teaches the method with said requiring of said capabilities being made during Phase B of a facsimile transmission, Phase B being a sequence of checking states of said transmitting part and a transmission line and controlling said transmitting part among a plurality of predetermined protocols used in transmission and reception of facsimile data (Phase B in fig. 8 and col. 11, lines 5-63).

However, looking at figure 8, and col. 5-63, there is no teaching or suggestion of the data output order being made in the Phase B of the transmitting part. Data compression and data sizing does not teach or suggest the data output order. Moreover, even if combined with Suzuki, such teaching is not made as Suzuki does not entail the transmitting part making such a feature, and instead it is the separately located storage exchange of Suzuki.

6. With respect to claim 8, as shown above concerning the remarks of claims 1 and 2, the combination of Suzuki and Kono fail to teach or suggest requiring a data output order by said

transmitting part from said receiving part when said call is connected; receiving said data output order by said receiving part from said transmitting part after said requiring of said data output order; transmitting said data of said document stored in said memory according to said received data output order; and displaying said data output order received from said receiving part on a display on an operational panel as claimed in claim 8. Quite clearly, Suzuki has a separate unit called the storage exchange 1 connected to the communication network 6 that handles the output order of the receiving part 8 rather than the transmission part 7. Moreover, as shown above, Kono also makes no teaching that the transmission side handles the output order of the receiving part. Therefore, the combination fails to teach or suggest all of the claimed limitations. In addition, as shown above, the display of Kono makes no teaching at all that the actual output order is displayed. The teachings or suggestion must be from the prior art or the combination according to MPEP §706.02(j) , and none of the above teachings are specifically taught or suggested by the combination.

**B. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Suzuki and Konno as applied to claim 1 above, and further in view of Ogura. The Applicant respectfully traverses.**

With respect to claim 7, since claim 7 is dependent on claim 1, the remarks concerning claim 1 are applicable and show that the combination does not teach or suggest all of the limitations and even when combined with Ogura, the combination still does not teach or suggest all of the limitations of claim 1 and therefore claim 7.

**C. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Suzuki and Konno as applied to claim 8 above, and further in view of Ogura. The Applicant respectfully traverses.**

The Examiner stated that with respect to claim 9, arguments analogous to those presented for claim 7, are applicable, with respect to claim 10, arguments analogous to those presented for claim 3, are applicable, with respect to claim 11, arguments analogous to those presented for claim 4, are applicable, with respect to claim 12, arguments analogous to those presented for claim 5, are applicable. However, as shown above in the related remarks, the combination of references fail to teach or suggest all of the claimed limitations.

**D. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Konno and in further in view of Bloomfield. The Applicant respectfully traverses.**

1. a. With respect to claim 13, the Examiner stated that Suzuki discloses an apparatus, comprising a control unit utilizing the digital image data from said scanner, said control unit controlling the transmitting part facsimile according to a system program, said control unit receiving a document output order from a receiving part facsimile, said document output order being an order of document pages determined by and being printed on said receiving part facsimile (receiving reply from a receiver side facsimile).

However, as shown above for the remarks of claim 1, Suzuki does not teach or suggest a control unit receiving a document output order from a facsimile receiving part where the control unit

controlling the facsimile transmitting part according to a system program. Suzuki on the other hand has a storage exchange section 1 separate from the transmission side facsimile 7 that manages the received document order. The storage exchange cannot fax while the separate transmission side 7 can. The storage exchange 1 does not control the transmission side fax 7 and therefore, the control unit of the present invention is not disclosed.

b. The Examiner also states that Suzuki teaches or suggests a memory storing said system program guiding said control unit, the digital image data from the document being stored in said memory before being transmitted to said receiving part facsimile by a transmission signal from said controller (last six lines).

However, the memory of the present invention also stores the system program guiding the control unit. However no such control is shown by the storage exchange 1 which has the terminal attribute table 33 in the output processing section 3. The storage exchange 1 of Suzuki is separate from the transmission side fax 7 and does not have the memory to store the controlling program for the transmission side facsimile 7.

c. The Examiner states that it is well known to one of ordinary skill in the facsimile art that any conventional facsimile machine has a scanner for scanning facsimile document, a memory for either temporarily or permanently storing the scanned document and a dialing means for dialing a receiving facsimile for making a communication path, and, it is well known in the art the facsimile communication is conventionally done over the telephone network using a modem.

However, Suzuki clearly does not have such properties in the storage exchange 1 which the

Examiner is using in the rejection as it is not a facsimile device like the separate element 7 which is the transmission side facsimile 7.

d. The Examiner stated that Suzuki, however, does not discloses expressly a control unit that sends a signal requiring a document output order and an operation panel having a plurality of keys generating key data of said transmitting part facsimile to said control unit, said operational panel having a display unit showing the document output order of said receiving part facsimile. However, the Examiner stated that Konno discloses a facsimile system having control unit that sends a signal requiring capabilities of receiving side and an operation panel having a plurality of keys generating key data of said transmitting part facsimile to said control unit (col. 10, lines 59-67), said operational panel having a display unit showing operational procedures (col. 10, lines 55-59).

However, merely showing a display unit and plurality of keys in Konno fails to teach or suggest a control unit that sends a signal requiring a document output order and an operation panel having a plurality of keys generating key data of said transmitting part facsimile to said control unit, and said operational panel having a display unit showing the document output order of said receiving part facsimile as Kono does not teaches that such keys and display are related to the data output order and Suzuki only involves a data output order in a storage exchange which is separate from the transmission side facsimile. The control unit of the present invention is controlling the facsimile of the transmission part as related to the keys and the display, but no such teaching is made in the combined references.

Moreover, Kono does not disclose expressly a control unit that sends a signal requiring a document output order as Kono never mentions that the document output order, but such things as

the compression of the image. Furthermore, even if combined with Suzuki, the control unit of the transmitting part still cannot control the document output order of the receiving part since Suzuki controls such operations in a separately located and connected storage exchange which is separate from the transmitting fax. Therefore, the combination would teach that a separate unit needed with a separate communication path since there is no suggestion that particularly the data output order can be controlled by the transmission fax controller and the disclosures made in Kono does not suggest that specifically unless the present invention is used to piece together the rejection.

e. The Examiner stated that Bloomfield teaches the network control unit forming the communication loop with the receiving part facsimile, however, when combined with Suzuki, that communication loop would also entail a connection with the storage exchange unit.

2. The Examiner stated that with respect to claim 14, arguments analogous to those presented for claim 3, are applicable, with respect to claim 15, arguments analogous to those presented for claim 4, are applicable, with respect to claim 16, arguments analogous to those presented for claim 5, are applicable, with respect to claim 17, arguments analogous to those presented for claim 6, are applicable. However, as shown above in the related remarks, the combination of references fail to teach or suggest all of the claimed limitations.

**E. Newly added claims 18 through 20.**

The newly added claims 18 through 20 are also not taught or suggested by any combination of in view of Suzuki Japanese publication No. 03-274943, Konno et al. U.S. Patent No. 6,154,286,

Ogura U.S. Patent No. 4,876,609 and Bloomfield U.S. Patent No. 6,693,729 since there is no teaching or suggestion of selecting an advance-transmitting function to accommodate said requiring said data output order by said facsimile transmitting part from said facsimile receiving part when said call is connected or the limitation of after the data output order of the facsimile data is displayed on a display of said operational panel, the facsimile data stored in a memory is then transmitted to said facsimile receiving part according to the displayed data output order, or the limitation of displaying said data output order when said data output order is received from said facsimile receiving part on a display on an operational panel.

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In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

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No fee is incurred by this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

  
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